

Appl. No. : 09/993,874
Filed : November 14, 2001

REMARKS

Claims 1 and 3 have been amended to clarify the invention. Support for the contingency conditions can be found on pages 10 and 11 of the specification, for example. Support for the light emission property can be found on pages 4, 5, 30 (the first paragraph), and 36 of the specification, for example. Claims 2, 4, and 5 have been canceled. Claims 6-11 have been added. Support for the new claims can be found throughout the specification. The specification has been amended to correct the informalities set forth in the Office Action.

The amendments do not constitute the addition of any new matter to the specification. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Priority

A certified copy of the Italian application has not been filed as requested by 35 U.S.C. 119(b). A certified copy of the Italian application is not yet available to Applicant. When it becomes available, Applicant will submit it.

IDS

An Information Disclosure Statement accompanies this Amendment.

Specification

The Examiner states "Applicant's request to delete Figures 1 and 2 filed November 14, 2001 is noted." If the request has been approved, Applicant will amend the specification as suggested by the Examiner. However, because there is no need to delete these figures, if the request has not been approved, Applicant wishes to withdraw the request. Applicant would appreciate it if the Examiner could inform Applicant of the status of the request.

Further, Applicant previously requested changing the Sequence Listing, but the request was not in compliance with the rules. Applicant respectfully requests withdrawal of the previous request.

The Examiner notes that GenBank accession AF139644 differs from SEQ ID NO:1 at nucleotide 1090. Applicant confirms that the nucleic acid at nucleotide 1090 is "A" as indicated in SEQ ID NO:1, and "G" indicated in GenBank accession AF139644 is incorrect.

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Additionally, the Examiner notes that AF139644 should be 1764 bp long on page 34, line 11 of the specification. The Examiner's statement is correct, and accordingly, the specification has been corrected.

The disclosure has been objected to with regard to the indication of browser-executable code on page 13, line 10 of the specification. Accordingly, the indication has been deleted.

Rejection Under 35 U.S.C. § 112, first paragraph

Claims 1, 2, and 4 have been rejected under 35 U.S.C. § 112, first paragraph, with regard to elements c) and e) of Claim 1. Claim 1 has been amended and deleted elements c), d), and e) for clarification. Further, the high stringency conditions and the light emitting property have been specifically defined in Claim 1 by amendment. Claims 2 and 4 have been canceled without prejudice. Thus, this rejection should be withdrawn.

Claim 3 has been rejected as being so broad as to encompass DNAs having unknown homology to SEQ ID NO:1 and encoding a luciferase. Claim 3 has been amended similarly to Claim 1. That is, the high stringency conditions and the light emitting property have been specifically defined in Claim 3 by amendment. Thus, this rejection should be withdrawn.

Claim 5 has been rejected under 35 U.S.C. § 112, first paragraph. Claim 5 has been canceled without prejudice. This rejection is no longer applicable.

Rejection Under 35 U.S.C. § 112, second paragraph

Claims 1-4 have been rejected under 35 U.S.C. § 112, second paragraph.

Claim 1 has been amended to clarify that Claim 1 is drawn to a nucleotide encoding a green light emitting luciferase (SEQ ID NO:1), whereas Claim 3 has been amended to clarify that Claim 3 is drawn to a nucleotide encoding a red light emitting luciferase (SEQ ID NO:3).

Claim 3 has been amended to clarify "high stringency conditions" by including the specific conditions.

Claim 4 has been canceled without prejudice.

Accordingly, this rejection should be withdrawn.

Rejection Under 35 U.S.C. § 102

Claims 1-5 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Viviani et al.

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However, Viviani et al. in fact describes the invention's own work. A declaration under Rule 1.132 by the present inventors is attached herein. Viviani et al. shows as authors the present inventors and another person. However, the person was merely working under the direction of the present inventors and was not an inventor. Thus, Viviani et al. cannot serve as 102(a) reference because the reference describes the inventors' own work.

Additionally, Viviani et al. cannot serve as a 102(b) reference because the present application is a continuation of the prior application filed on March 1, 2000 (which is a continuation-in-part of the previous application filed on September 1, 1999), whereas Viviani et al. was published on June 4, 1999, which is less than one year from the filing date of the prior application.

In conclusion, Viviani et al. cannot serve as prior art, and accordingly, this rejection should be withdrawn.

Claims 6-11

Claims 6-11 have been added. These claims are dependent ultimately on Claim 1. At least for the reason, these claims should be allowable as with Claim 1.

CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 13, 2004

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